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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR           | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|--------------------------------|---------------------|------------------|
| 09/913,020  | 05/06/2002  | Elaine Sophie Elizabeth Stokes | P 282705            | 5058             |
| 9629  | 7590        | 09/07/2004                     | EXAMINER            |                  |
| MORGAN LEWIS & BOCKIUS LLP<br>1111 PENNSYLVANIA AVENUE NW<br>WASHINGTON, DC 20004 |             |                                | RAYMOND, RICHARD L  |                  |
|   |             |                                | ART UNIT            | PAPER NUMBER     |
|   |             |                                | 1624                |                  |

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/913,020

Applicant(s)

STOKES ET AL.

Examiner

Richard L. Raymond

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 39-41, 43-49, 51, 61 and 63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 39-41, 43-49, 51 and 61 is/are rejected.
- 7) ☒ Claim(s) 63 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/9/01, 7/14/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Change of Examiner***

1. Note the change of examiner in the present application. The Art Unit number (1624) remains the same.

### ***Response to Amendment***

2. The Response of July 14, 2004 canceled claims 42 and 62 and added new claim 63. Accordingly, the claims now pending are claims 39-41, 43-49, 51, 61 and 63.
3. In view of the amendments and arguments presented in the Response, all the rejections of record have been overcome.
4. Upon review of the record and an additional search in the literature (STN/CAS) the following new ground of rejection is, however, seen necessary.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 39-41, 43-45, 49 and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by either of the newly cited Sinyak et al. and Karminski et al. Chemical Abstracts references. See the STN/CAS printouts for the present compounds where Z<sub>b</sub>

is S, and ring C is a quinoliny ring, and Z<sub>b</sub> is O or S and ring C is a quinazolinyl ring. Note also that R<sup>2</sup> in the present compounds can be H when it is -X<sup>1</sup>R<sup>5</sup> where X<sup>1</sup> is a bond and R<sup>5</sup> is H).

***Claim Rejections - 35 USC § 103***

7. Claims 39-41, 43-49, 51 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over the above cited Chemical Abstracts references. Where not anticipated, one would be motivated to prepare the present compounds from within the generic teachings of the references and/or to prepare the present homologs and isomers of the specific compounds of the references with the reasonable expectation of obtaining additional compounds for the uses in the references. In the absence of a showing of unexpected properties, no patentable significance is seen in the present selection.

***Allowable Subject Matter***

8. Claim 63, drawn to method of use, is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, or upon allowance of a claim generic thereto.

***Conclusion***

9. This action is not made final.

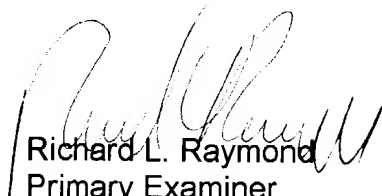
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Art Unit: 1624

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard L. Raymond whose telephone number is (571) 272-0673. The examiner can normally be reached on maxi-flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on (571) 272-0674. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Richard L. Raymond  
Primary Examiner  
Art Unit 1624

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September 3, 2004